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EXAMINER

PHAM, KHANH B

ART UNIT	PAPER NUMBER
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2177

19

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 19

Application Number: 09/847,999
Filing Date: May 04, 2001
Appellant(s): INGRAM ET AL.

Geoffrey L. Oberhaus
For Appellant

MAILED
MAR 23 2004
Technology Center 2600

EXAMINER'S ANSWER

This is in response to the appeal brief filed February 11, 2004.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 31-33 stand or fall together.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

- 5,742,768 Gennaro et al. 4-1998
- 2003/0030679 A1 Jain 2-2003

- Newfield et al., "Scratchpad: mechanisms for better navigation in directed web searching", Proceedings of the 11th annual ACM Symposium on User Interface Software and Technology, 1998, pages 1-8.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

As per claim 31, Newfield teaches a method of operating a computer, comprising:

- "providing a visual display; displaying digital content in a first window on the visual display, the digital content including a hyperlink" at page 6, Fig. 2;
- "providing a graphical interface on the visual display that is operative to effectuate a designation of a hyperlink" at page 6, Fig. 2;
- "visually generating a plurality of individually selectable user options on the visual display in response to the designation of the hyperlink, including at least one option for performing the non-linking functionality of automatically copying the

hyperlink to a second window in a manner that permits the copied hyperlink to be independently activated and processed” at page 5, Col. 1, 2nd paragraph and Fig. 1;

- “selecting the individually selectable user option of copying the hyperlink to a second window and automatically performing such non-linking functionality of automatically copying the hyperlink to a second window in response to the selection” at page 5, Col. 1, 2nd paragraph and Fig. 1;

Newfield does not teach: “visually generating a plurality of individually selectable user options on the visual display in response to the designation of the hyperlink”. However, Gennaro teaches a similar method for navigating hyperlink, including the steps of: “visually generating a plurality of individually selectable user options on the visual display in to the designation of the hyperlink” at Col. 2 lines 48-53 and Figs. 2A-B.

Thus, it would have been obvious to one of ordinary skill in the art at the time of invention to combine Newfield and Gennaro’s teaching to display available options to user “in response to a positioning of a pointer at or near the hyperlink” without requiring user to click on the hyperlink, in order to “provide an easier and more efficient way to access information form that web page” (Gennaro, Col. 2 lines 45-50).

Newfield and Gennaro do not explicitly teach: “the non-linking functionality further comprises copying any associated graphical elements corresponding to the hyperlink to the second window, and further wherein the associated graphical element comprises a graphical image embedded in the hyperlink” as claimed.

However, Jain teaches a similar method for copying hyperlink to bookmark window (see Abstract), including the step of: "copying any associated graphical element corresponding to the hyperlink to the second window" at Col. 2, [0022]. Thus, it would have been obvious to one of ordinary skill in the art at the time of invention was made to modified Newfield and Gennaro's teaching in view of Jain such that the graphical element associated with the hyperlink is copied to the second window in order to make it easier for user to recognize the hyperlink just by viewing its associated graphical image. Jain also teaches: "the associated graphical element comprises a graphical image embedded in the hyperlink" at Fig. 10, elements 1002, 1003, 1004, 1005.

As per claim 32, Newfield, Gennaro and Jain teach the method of claim 31 as discussed above. Gennaro also teaches: "the designation of a hyperlink comprises positioning a pointer at or near the hyperlink" at Col. 2 lines 45-55.

As per claim 33, Newfield, Gennaro and Jain teach the method of claim 31 as discussed above. Newfield also teaches: "the second window comprises a temporary, session-based window" at page 5, Col. 1, 2nd paragraph.

(11) Response to Argument

A. The Rejection Under 35 U.S.C §103

1. Summary of Appellant's Invention

Appellant's invention is directed to a method which allows viewer of a web page to copy a hyperlink to a second window so that the viewer can "check the Hyperlink out later"(Appellant's specification, page 8, [0034]). The method, as interpreted in the Ground of Rejection above (Section 10), performs the following functions:

1. Displaying a web page content on a first window;
2. Positioning a mouse pointer at or near a hyperlink;
3. Presenting the user a menu of plurality of selectable options, including an option for copying the hyperlink to a second window;
4. User selects the copying option;
5. Copying the hyperlink to the second window;
6. Copying the graphic image embedded in the hyperlink to the second window in response to user selection.

2. Summary of The Rejection

The examiner rejected claims 31-33 as non-obvious over Newfield, Gennaro and Jain, and provides motivations to combine the references as set forth in section 10, Ground of Rejection, above.

Newfield teaches a method which allows viewer of a web page to copy a hyperlink to a second window to be checked out later (Fig. 2, "Pending links" window), and therefore teaches appellant's steps 1, 4 and 5 listed above. Newfield also teaches

copying the hyperlink and the text embedded in the hyperlink to the second window.

However, Newfield does not explicitly teach copying the graphic image embedded in the hyperlink to the second window.

Consequently, Gennaro was relied upon for its teaching of a method of presenting a menu of plurality of selectable options to the user when a mouse pointer is at or near a hyperlink (Fig. 2B, element 46), and therefore teaches appellant's steps 2 and 3 listed above.

Additionally, Jain was relied upon for its teaching of a method for allowing a web page viewer to select one of the image on the web page, and storing the image together with a hyperlink in a book mark window to help the viewer remember and distinguish the hyperlink by just looking at the image (See Abstract). Jain suggests the use of image instead of text to represent a hyperlink, and therefore teaches appellant's step 6 listed above.

3. Response to Appellant's Arguments

Appellant argued that Newfield, Gennaro, and Jain, alone or in combination, do not disclose or suggest the step of: "copy a hyperlink including any associated graphical elements corresponding to the hyperlink to a second window, and further wherein the associated graphical element comprises a graphical image embedded in the hyperlink". The examiner respectfully traverses appellant's argument.

First, Jain teaches the step of "copying **any** associated graphical element **corresponding** to the hyperlink to the second window" at page 2, [0023] recited below:

"The user may select the whole image, such as 1002 in FIG. 10, or a portion of it, by enclosing the desired part of the image

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within an automatically generated box tool 1006 which is displayed by the BWI module upon its activation in 1106. Next, in step 1110 of FIG. 11, the BWI module preferably resizes the user-selected image to the appropriate size to be put in front of the URL address 1000."

As clearly seen in Fig. 10 reproduced below, the image 1002 is copied to a second window, and placed in front of the URL 1000.

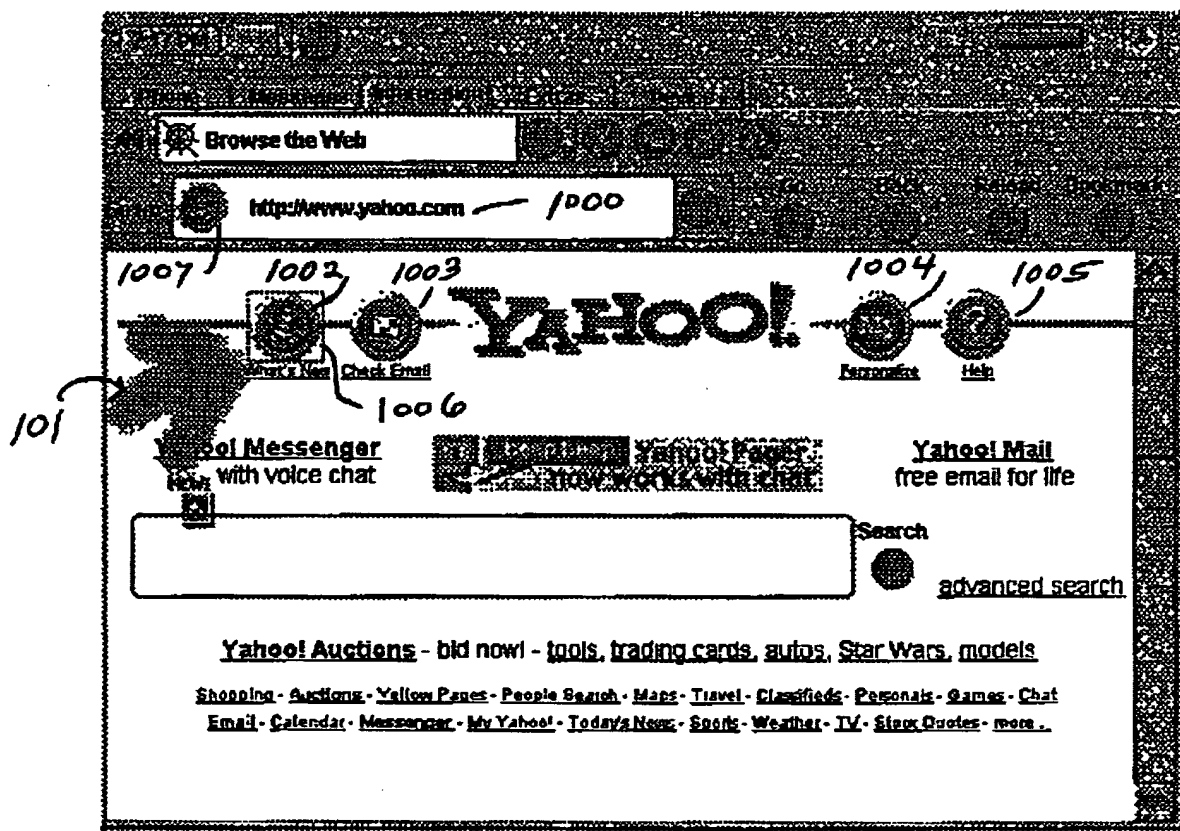


Figure 10 Proposed Implementation

The image 1002 is also "a graphical image embedded in the hyperlink" because user can click on the image to activate the hyperlink. As noted by Appellant, "graphical image embedded in a hyperlink" is well known in the art (Appeal Brief, page 8). For example, a user can click either the text "Check Mail" or the graphic 1003 to activate the

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hyperlink to the web page for checking email. Jain does not explicitly state that graphic 1002 is clickable to activate the hyperlink, or in other words, is a "graphical image embedded in the hyperlink". However, using the Wayback Machine*, the examiner was able to obtain an archived version of Yahoo.com web page dated April 17, 1999, which is very similar to Jain's Fig. 10 (See Appendix A-3), and the images 1002, 1003 are indeed, graphical images embedded in hyperlinks. This fact can be easily verified using the Wayback Machine as showed in Appendix A1-A3. Therefore, Jain's method allows user to copy a hyperlink (i.e., the link to "What's New" or "Check Email" web pages) to a second window (i.e., The bookmark window), wherein the image embedded in the hyperlink (i.e., image 1002, 1003) is also copied to the second window.

Moreover, the examiner submits that even if Newfield does not explicitly teach the step of "copy a hyperlink including any associated graphical elements corresponding to the hyperlink to a second window", Newfield does suggest the use of graphical image in an embodiment as recited below:

"Currently the scratchpad is implemented as a separate window in which both the pending links and the dogears are displayed as **text list**. The scratchpad concept, however, does not preclude integration into the browser window, or the use of an alternate display technique, such as a site map display, or some other **graphical form**."

(Newfield, page 5, Col. 1, 2nd paragraph).

Newfield also teaches: "selecting a link in the browser with the left mouse button causes the link to be added to the bottom

* The Internet Archive Wayback Machine is a service that allows people to visit archived versions of Web sites. Visitors to the Wayback Machine can type in a URL, select a date range, and then begin surfing on an archived version of the Web.

of the pending queue in the scratchpad". Therefore, the second window contains an exact copy of the link. It is well known in the art, as noted by appellant, that a link, or hyperlink, "begins with the hyperlink opening tag, then any text or images to be displayed with the hyperlink are embedded" (Appeal Brief, page 8). Newfield's step of copying the link to a second window can be implied that the second part of the hyperlink, which is "any text or images" embedded in the link, are also copied because the link comprises "any text or images".

In conclusion, Newfield, Gennaro and Jain, as combined, teach each and all limitations of appellant claimed invention. The motivation to combine references have been provided. The prima facie case of obviousness has been established. Appellant seem to rely on a well-known subject matter "a graphical image embedded in the hyperlink" to argue that the claimed invention is non-obvious and patentable. The 103 rejection is therefore should be sustained.

B. The Provisional Rejection Under 35 U.S.C. 101

Since appellant do not contest the Examiner's provisional double patenting rejection, the examiner does not need to response to this issue.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

Khanh B. Pham
Examiner
Art Unit 2177

KBP

March 12, 2004

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Appendix A-1


Internet Archive - Microsoft Internet Explorer provided by USPTO

File Edit View Favorites Tools Help

Back Forward Stop Refresh Home Search Favorites History Mail Print Edit

Google Search Web 1619 blocked AutoFill Options Go

Address http://www.archive.org

INTERNET ARCHIVE  **Web | Moving Images | Texts | Audio | Patron Info** **Universal access to human knowledge**

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Announcements (more)


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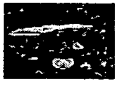
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From the staff pick list:

 **[Amateur film: New Orleans Carnival Week, February 22, 1941](#)**
Mardi Gras: Parade of Nor.

Audio: [Live Music Archive](#) | [Netlabels](#) | [Democracy Now](#) | [Open Source Audio](#) | [Other Minds Archive](#)

From the staff pick list:

 **[Elektronaut - The Slipstream Syndrome \[UHZMP3002\]](#)**
Elektronaut flirts with minimal tech-house on this double A-side release, completed just in time for the Microdisco 2002 event.

Texts: [Project Gutenberg](#) | [Million Book Project](#) | [Arpanet](#) | [Open Source Books](#) | [Internet Bookmobile](#) | [Children's Library](#) | [Dance](#)

This Just In (more)

[Mosaic20040304](#)
11.71 hours ago

[-1348- - Crystal Night \[zero102a\]](#)
15.09 hours ago

[Keller Williams: 2004-03-01](#)
16.30 hours ago

[Bharath Bharathi](#)
16.46 hours ago

Add your own [concert](#), [audio recording](#), [movie](#), or [text](#) to the Internet Archive.

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Appendix A-2

Internet Archive Wayback Machine - Microsoft Internet Explorer provided by USPTO

File Edit View Favorites Tools Help

Back Forward Stop Refresh Home Search Favorites History Mail Print Edit

Google Search Web 1019 blocked AutoFill Options

Address http://web.archive.org/web/*www.yahoo.com

INTERNET ARCHIVE
WaybackMachine

Enter Web Address: All Adv. Search Compare Archive Pages

Searched for http://www.yahoo.com **24921 Results**

Note some duplicates are not shown. [See all](#).
* denotes when site was updated.

Search Results for Jan 01, 1996 - Mar 05, 2004

1996	1997	1998	1999	2000	2001	2002	
12 pages	29 pages	9 pages	18 pages	197 pages	1280 pages	186 pages	2
Oct 17, 1996 *	Jan 09, 1997 *	Feb 10, 1998 *	Jan 16, 1999	Feb 29, 2000 *	Jan 24, 2001 *	Jan 19, 2002 *	Ja
Oct 20, 1996 *	Jan 24, 1997 *	Feb 13, 1998 *	Jan 17, 1999	Feb 29, 2000 *	Feb 01, 2001 *	Jan 23, 2002 *	Ja
Oct 22, 1996 *	Feb 01, 1997 *	Feb 15, 1998 *	Feb 08, 1999 *	Feb 29, 2000 *	Feb 01, 2001 *	Jan 25, 2002 *	Ja
Oct 23, 1996 *	Feb 09, 1997 *	Jul 03, 1998 *	Apr 17, 1999 *	Mar 01, 2000 *	Feb 02, 2001 *	Jan 25, 2002 *	Ja
Nov 28, 1996 *	Feb 09, 1997 *	Jul 04, 1998 *	Apr 18, 1999 *	Mar 01, 2000 *	Feb 08, 2001 *	Jan 25, 2002 *	Fe
Dec 19, 1996 *	Feb 27, 1997 *	Jul 05, 1998 *	Apr 19, 1999 *	Mar 01, 2000 *	Feb 24, 2001 *	Feb 02, 2002 *	Fe
Dec 20, 1996 *	Feb 27, 1997 *	Dec 12, 1998 *	Apr 19, 1999 *	Mar 02, 2000 *	Feb 24, 2001 *	May 23, 2002 *	Fe
Dec 21, 1996 *	Mar 30, 1997 *	Dec 12, 1998 *	Apr 21, 1999 *	Mar 02, 2000 *	Feb 26, 2001 *	May 24, 2002 *	Fe
Dec 22, 1996 *	Apr 16, 1997 *	Dec 12, 1998 *	Apr 21, 1999 *	Mar 02, 2000 *	Feb 26, 2001 *	May 25, 2002 *	Fe
Dec 26, 1996 *	Apr 18, 1997 *		Apr 24, 1999 *	Mar 02, 2000 *	Mar 01, 2001 *	May 25, 2002 *	Fe
Dec 27, 1996 *	Apr 18, 1997 *		Apr 27, 1999 *	Mar 02, 2000 *	Mar 02, 2001 *	May 25, 2002 *	Fe
Dec 28, 1996 *	Apr 24, 1997 *		Apr 28, 1999 *	Mar 03, 2000 *	Mar 05, 2001 *	May 27, 2002 *	Fe
	Apr 24, 1997 *		Apr 29, 1999 *	Mar 03, 2000 *	Mar 05, 2001 *	May 29, 2002 *	Fe
	May 05, 1997 *		Apr 30, 1999 *	Mar 03, 2000 *	Mar 06, 2001 *	May 29, 2002 *	Fe
	May 17, 1997 *		May 08, 1999 *	Mar 03, 2000 *	Mar 07, 2001 *	May 30, 2002 *	Ma
	May 21, 1997 *		Oct 10, 1999 *	Mar 03, 2000 *	Mar 31, 2001 *	May 30, 2002 *	Ma
	May 23, 1997 *		Oct 13, 1999 *	Mar 03, 2000 *	Mar 31, 2001 *	May 30, 2002 *	Ma
	May 23, 1997 *		Nov 14, 1999 *	Mar 03, 2000 *	Mar 31, 2001 *	May 31, 2002 *	Ma
	Jun 05, 1997 *			Mar 03, 2000 *	Mar 31, 2001 *	May 31, 2002 *	Ma
	Jun 06, 1997 *			Mar 04, 2000 *	Mar 31, 2001 *	May 31, 2002 *	Ma
	Jun 30, 1997 *			Mar 04, 2000 *	Apr 01, 2001 *	Jun 01, 2002 *	Ma
	Jul 03, 1997 *			Mar 04, 2000 *	Apr 01, 2001 *	Jun 03, 2002 *	Ac
	Jul 23, 1997 *			Mar 04, 2000 *	Apr 01, 2001 *	Jun 03, 2002 *	Ac
	Aug 05, 1997 *			Mar 05, 2000 *	Apr 04, 2001 *	Jun 06, 2002 *	Ac
	Oct 07, 1997 *			Mar 07, 2000 *	Apr 04, 2001 *	Jul 02, 2002 *	Ac
	Oct 08, 1997 *			Apr 07, 2000 *	Apr 05, 2001 *	Jul 03, 2002 *	Ac
	Oct 14, 1997 *			Apr 07, 2000 *	Apr 05, 2001 *	Jul 03, 2002 *	Ac

http://web.archive.org/web/*www.yahoo.com/ Internet

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Appendix A-3

Yahoo! - Microsoft Internet Explorer provided by USPTO

File Edit View Favorites Tools Help

Back Forward Stop Refresh Home Search Favorites History Mail Print Edit

Google Search Web 1619 blocked AutoFill Options Go

Address http://web.archive.org/web/19990417092011/http://www2.yahoo.com/

YAHOO! My ?

What's New Check Email Personalize Help

Yahoo! Pager instant messaging **beep beep Yahoo! Pager** now works with chat **Yahoo! Mail** free email for life

Search advanced search

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Email - Calendar - Pager - My Yahoo! - Today's News - Sports - Weather - TV - Stock Quotes - more...

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Education <u>College and University</u> , <u>K-12</u> ...	Regional <u>Countries</u> , <u>Regions</u> , <u>US States</u> ...		Inside Yahoo! <ul style="list-style-type: none"> • <u>Y! Movies</u> - showtimes, reviews • <u>Y! Clubs</u> - create your own • <u>Y! Visa</u> - instant credit while you wait <u>more...</u>
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Health <u>Medicine</u> , <u>Diseases</u> , <u>Drugs</u> , <u>Fitness</u> ...	Society & Culture <u>People</u> , <u>Environment</u> , <u>Religion</u> ...		

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